



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,615	03/29/2001	Ervin Dennis Walter	29794/36547A	4103

23598 7590 05/01/2007
BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.
250 E. WISCONSIN AVENUE
SUITE 1030
MILWAUKEE, WI 53202

EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
----------	--------------

3626

MAIL DATE	DELIVERY MODE
-----------	---------------

05/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/821,615	Applicant(s) WALTER ET AL.	
	Examiner Luke Gilligan	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 2/14/07, the following has occurred: claims 55, 63, and 68 have been amended. Now, claims 55-70 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 55-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 55 has been amended to recite "clinical information specific to given patients and sufficient for the delivery of medical services to those patients..." It is unclear how the term "sufficient" limits the scope of the claim because it is unclear exactly what "clinical information specific to given patients" must be included to meet a level of "sufficient" for delivery of medical services. In addition, claim 55 has been amended to recite the phrase "the same location is access by both provider as a principal reference in the delivery of medical services to the patient, and patient..." it is unclear to what degree the database must be used as a reference to meet a level of "a principal reference." Therefore, the scope of the claim is unclear and indefinite.
5. Claim 63 has been amended in the same manner as claim 55 and, therefore, is rejected for the same reasons as given above.
6. Claims 56-62 and 64-70 are rejected for the same reasons as given above through their dependency on claims 55 and 63.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 55-57, 61-66, and 69-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Hacker, U.S. Patent No. 6,988,075.

9. As per claim 55, Hacker teaches a patient accessible, healthcare organization controlled, medical record system comprising: a patient accessible medical record database holding clinical information specific to given patients and sufficient for the delivery of medical services to those patients, the medical record database defined by a single data model describing a location for each clinical information data element within the database, wherein the same location is accessed by both provider as a principal reference in the delivery of medical services to the patient, and patient (see column 7, lines 22-33); and a web portal reading from the medical record database to deliver the clinical information directly to the patient (see column 8, lines 46-49); whereby direct patient-access to clinical medical records is provided (see 9, lines 1-11).

10. As per claim 56, Hacker teaches the system of claim 55 as described above. Hacker further teaches the medical record database holds diagnostic test results for patients and wherein the web portal delivers the diagnostic test results directly to the patient

11. As per claim 57, Hacker teaches the system of claim 55 as described above. Hacker further teaches the web portal communicates with the medical record database using a secure

Art Unit: 3626

communication channel (see column 7, lines 60-66), the secure communication channel: (a) allowing viewing modification of clinical information in the medical record database by a physician using the medical record database (see column 7, lines 56-60); (b) allowing viewing of clinical information in the medical record database by a patient using the web portal (see column 8, lines 46-49); (c) preventing modification of clinical information in the medical record database by a patient using the web portal (see column 8, lines 46-49, it appears that patients do not have the capability of modifying clinical information in the database).

12. As per claim 61, Hacker teaches the system of claim 55 as described above. Hacker further teaches the web portal further receives appointment scheduling tasks to automatically update an appointment in the medical record database (see column 9, lines 47-53).

13. As per claim 62 Hacker teaches the system of claim 55 as described above. Hacker further teaches the web portal further communicates electronic messages between the patient and the patient's physician (see column 9, lines 26-32).

14. Claim 63 recites substantially similar limitations to those already addressed in claim 55 with the additional limitation that the system includes at least one duplicate medical record database, the original and the duplicate each holding identical clinical information specific to given patients. Hacker further teaches the system can include at least one duplicate medical record database, the original and the duplicate each holding identical clinical information specific to given patients (see column 8, lines 25- 45, it is noted that by updating an outside medical information system and the medical information database through the disclosed emailing of attachments, certain patient-specific clinical information is identical between the two information sources).

15. Claims 64 and 69-70 recite substantially similar additional limitations to claims 56 and 61-62 and, as such, are rejected for similar reasons as given above.

Art Unit: 3626

16. As per claim 65, Hacker teaches the system of claim 63 as described above. Hacker further teaches the patient and physician access different ones of the original or duplicate databases (see column 8, lines 25-45).

17. As per claim 66, Hacker teaches the system of claim 63 as described above. Hacker further teaches the patient and physician access same database (see column 8, lines 4-7).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 58-60 and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker, U.S. Patent No. 6,988,075 in view of Ilse, U.S. Patent No. 6,757,898.

20. As per claim 58, Hacker teaches the system of claim 55 as described above. Hacker does not explicitly teach fields for accepting patient-created data and wherein the web portal further receives information from the patient and writes that information to the medical record database in the fields accepting patient-created data. However, Ilse teaches a system that includes fields for accepting patient-created data and receiving information from the patient and writing that information to a medical record database in the fields accepting patient-created data (see column 21, Table 1, in particular, the forms for accepting patient created data). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Hacker. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing greater access to and control over patient medical records (see column 6, lines 18-19).

Art Unit: 3626

21. As per claim 59, Hacker in view of Ilсен teaches the system of claim 58 as described above. As described above, Hacker does not explicitly teach the fields accepting patient-created data. Ilсен further teaches the fields accepting patient-created data are logically separated from clinical information in the medical record database (see column 21, Table 1, it appears that the acceptance of such data is separate from other clinical information maintained by the system of Ilсен). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Hacker for the reasons given above with respect to claim 58.

22. As per claim 60, Hacker in view of Ilсен teaches the system of claim 58 as described above. As described above, Hacker does not explicitly teach the fields accepting patient-created data. Ilсен further teaches the fields accepting patient-created data include flags triggering a notification to a patient's physician (see column 21, Table 1, in particular, appointments can be requested). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Hacker for the reasons given above with respect to claim 58.

23. Claims 67 and 68 recite substantially similar additional limitations to those already addressed in claims 58 and 59 and, as such, are rejected for similar reasons as given above.

Response to Arguments

24. In the remarks filed 2/14/07, Applicants argue in substance that (1) the database of Hacker cannot be the principal medical record used by a medical provider to manage the health of the patient; (2) because of an "implicit, second 'clinical database' relied upon by the physician" in Hacker, Hacker teaches away from using a single database.

25. In response to Applicants' argument (1), as noted above, it is unclear to what degree the medical record needs to be used to meet a level of "principal" as now claimed. Nevertheless, throughout Hacker, it is clear that the medical records that are stored in the common medical record database are the medical records used for the delivery of healthcare services to the patient (see for example column 7, line 51 – column 8, line 17). Therefore, the Examiner does not find this argument to be persuasive.

26. In response to Applicants' argument (2), it is respectfully maintained that, throughout Hacker, only a single database is contemplated for common use by both patient and physician. There has also been no citation given within Hacker to support the alleged "implicit" second database. Furthermore, Applicants' have not cited any portion of Hacker that specifically disparages the use of a single database. Therefore, Hacker cannot be said to teach away from the use of a single database. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

28. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3626


CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/26/07


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600